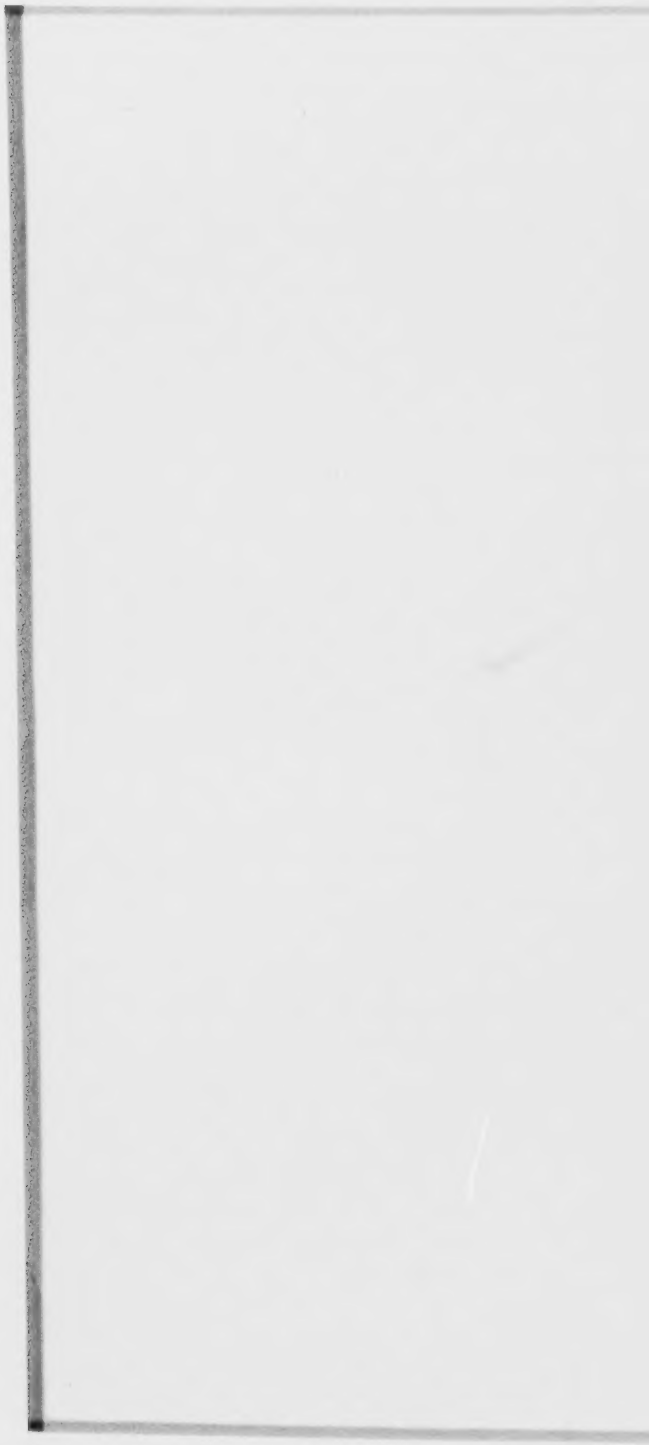

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1940

No. 396

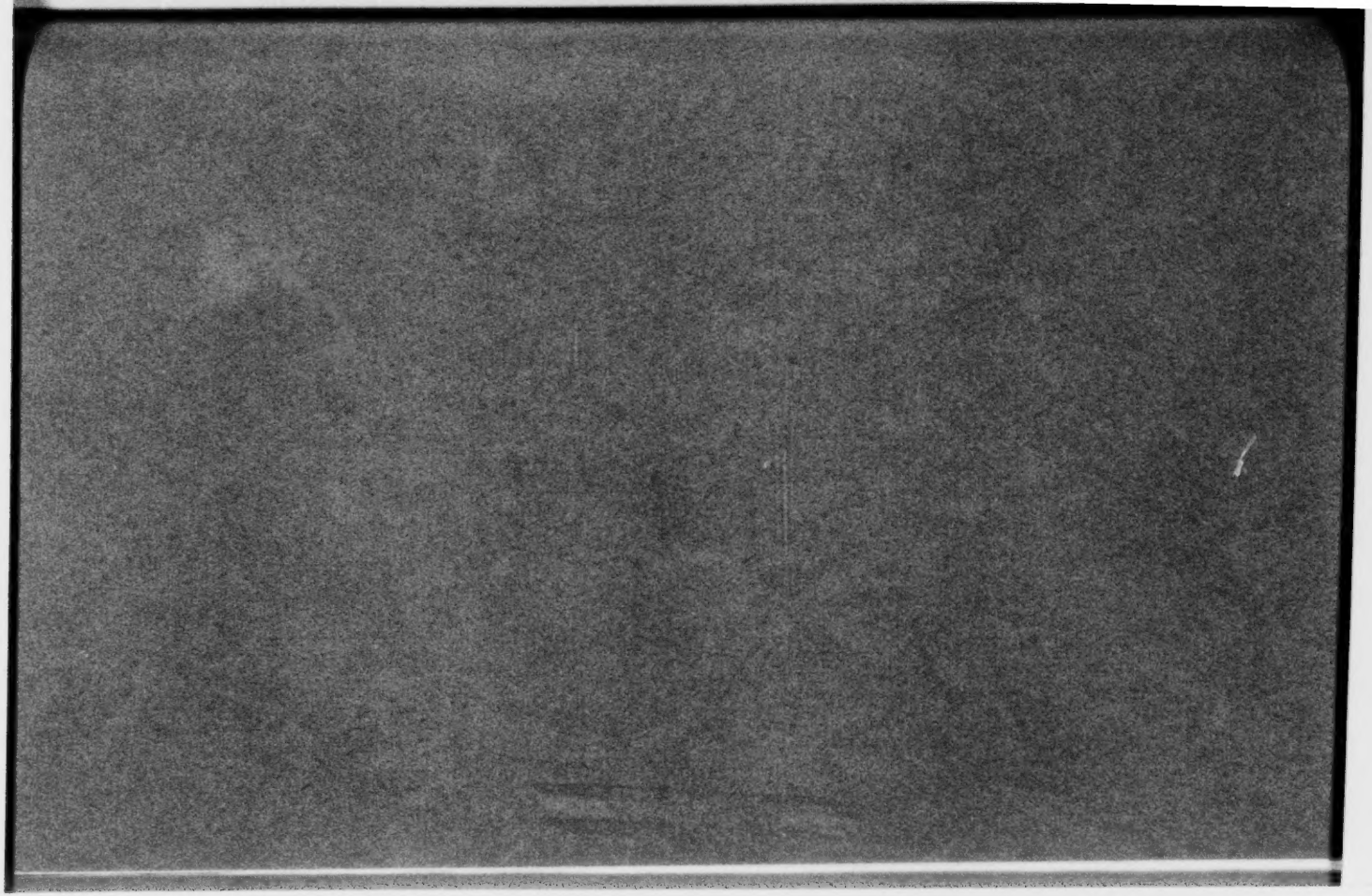
THE HAMILTON LABORATORIES, INC.
Petitioner

vs.

SAMUEL E. MASSENGILL, doing business as
THE S. E. MASSENGILL COMPANY
Respondent

PETITIONER'S REPLY BRIEF

W. B. MORTON
Counsel for Petitioner



SUBJECT INDEX

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QUESTION II. Patent claims to a defined group of chemical compounds possessing the essential characteristics for the stated purpose are not invalid (The Incandescent Lamp Patent, 159 U. S. 465) ... 2

QUESTION III. The claims of the patent are not invalid because based on a discovery made in the course of research in a field recommended for study in a prior publication (Corona v. Dovan, 276 U. S. 358) 2

QUESTION IV. The patentee is not estopped to contest the pertinence of a prior patent cited during the Patent Office prosecution of a companion application (Smith v. Snow, 294 U. S. 1) 3

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Question I

Respondent concedes the Circuit Court of Appeals decided that a typewritten thesis filed in a college library is a "printed publication" within the meaning of the Statute (R. S. 4886; U. S. C., title 35, Sec. 31) and does not deny that this Court has never passed on this important question of federal statute law. Respondent merely argues that the thesis in question was not the "determinative" ground of the Circuit Court of Appeals decision. Whether that Court based its conclusion on additional grounds is without significance. The significant factors, not denied by respondent, are that the question is presented, and that the question has not been but should be settled by this Court.

Question II

Respondent does not deny that this question as stated by petitioner conflicts with the lower Court decisions cited in petitioner's brief, and concedes the question has not been settled by this Court (respondent's brief, p. 3). Respondent denies that the question is presented. It is clear from a reading of the Circuit Court of Appeals' opinion at Rec. p. 729 that the question was passed on by that Court and is presented here. The Circuit Court of Appeals said:

> "the patentee has experimented with but 20 [compounds] falling within the scope of the claims as including the effective phenylmercuric radical in the form prescribed. Since all the compounds so made and tested were found to be effective, it is concluded that all within the group likewise are. But the patent is not limited to the results achieved by the patentee's research * * * the claims are too broad and so, under familiar rules, invalid." (Bracket insert petitioner's).

Question III

The question as presented by petitioner is not misleading. The Circuit Court of Appeals said the question was whether in view of the White article "nothing more was required than routine experimentation by the skilled chemist" (Rec. p. 728). In answering this question, the Court makes clear its position that "convincing evidence of seemingly insuperable difficulties encountered on the road * * *" is a necessary prerequisite to a finding that the patentee's discovery was invention rather than routine experiment. This is clearly in conflict with the established doctrine that the unique property of the thing discovered and not the ease or difficulty with which the discovery was made controls on the question of invention.

Question IV

This question is clearly presented. The Circuit Court of Appeals noted that Weed (the patentee) submitted to the rejection of his prior abandoned application on a seed disinfectant patent, and held this submission established an analogy between the arts of producing disinfectants for plants and germicides for humans (Rec. p. 730). Thus the Court held the patentee's former submission to be an estoppel on the question of anticipation by analogous art. The conflict between this ruling and that established by this Court is explained in petitioner's brief.

Respectfully submitted,

W. B. MORTON
Counsel for Petitioner